

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DALE F. McINTYRE, CHRISTOPHER C. CEGELSKI
and JOHN K. McBRIDE



Appeal No. 2006-1498
Application No. 09/973,031

ON BRIEF

Before FRANKFORT, OWENS, and BAHR, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from a rejection of claims 1, 3-12, 32 and 33. Claim 2 has been canceled and claims 13-31 have been withdrawn from consideration by the examiner. Claim 33 is indicated in the examiner's answer as containing allowable subject matter (page 4).

THE INVENTION

The appellants claim an album leaf having an insert with information relating to a plurality of images on the album leaf. Claim 1 is illustrative:

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1. An image product assembly, comprising:

a dual sided album leaf having a first ply layer and a second ply layer, said first and second ply layers each having an outer surface and an inner surface, said first and second ply layers are secured together so as to form a pocket there between, said outer surface of said first and/or second ply layer having a plurality of images formed thereon; and

an insert having a size and configuration such that it can be placed within said pocket, said insert having information thereon that relates to said plurality of images, said information on said insert is located in a position on said insert such that it can be readily identified with respect to which of said plurality of images it is associated.

THE REFERENCE

Fountain	370,186	Sep. 20, 1887
Hawley	3,848,348	Nov. 19, 1974
Young	6,061,938	May 16, 2000

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as follows:
claims 1, 3-6, 12 and 32 over Fountain, claim 7 over Fountain in view of Young, and claims 8-11 over Fountain in view of Hawley.¹

¹A rejection of claim 33 under 35 U.S.C. § 112, first paragraph, is withdrawn in the examiner's answer (page 4).

OPINION

We reverse the aforementioned rejections. We need to address only the sole independent claim, i.e., claim 1.²

Claim 1 requires an insert which has information thereon that relates to a plurality of images on an outer surface of a ply layer of a dual sided album leaf, and is located in a position on the insert such that it can be readily identified with respect to which of the plurality of images the information is associated.

Fountain discloses a biographical photograph card having, in its lower portion, a recess (20) within which a blank (10) fits (lines 41-43). A biographical record of a person whose photograph is shown in the upper part of the card is written on the forward face of the blank (lines 51-54). The blank normally is housed within a pocket in the lower portion of the card, and when it is desired to refer to the biographical record, the blank is pulled out of the pocket by use of a finger tab (12) (lines 56-59).

²The examiner does not rely upon Young or Hawley for any disclosure that remedies the deficiency in Fountain as to the independent claim.

The examiner argues that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to include as many images [on Fountain's card] as desired, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art" (answer, page 5). The examiner is relying on a per se rule of obviousness. As stated by the Federal Circuit in *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995), "reliance on per se rules of obviousness is legally incorrect and must cease." For a prima facie case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. See *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). The examiner has not explained how Fountain itself would have fairly suggested a plurality of images to one of ordinary skill in the art.

The examiner argues that "biographical" relates to an account of the life of something, and that because "life of something" can pertain to either a single person or a group, Fountain would have fairly suggested, to one of ordinary skill in the art, displaying separate images of the members of a group (answer, page 5). Even if one of ordinary skill in the art had

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considered "life of something" to possibly pertain to a group, the examiner has not established that Fountain would have fairly suggested, to such a person, showing the members of the group in separate images. The record indicates that the examiner's motivation for using separate images comes from the appellants' disclosure rather than coming from the applied reference and that, therefore, the examiner used impermissible hindsight in rejecting the appellants' claims. See *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960).

The examiner argues that there is no functional relationship between the appellants' printed matter and the substrate (answer, p. 6). The functional relationship is that the printed matter must be located in a position on the insert such that it can be readily identified with respect to which of a plurality of images on the outer surface of a ply layer the information is associated.

For the above reasons we conclude that the examiner has not carried the burden of establishing a prima facie case of obviousness of the appellants' claimed invention.

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DECISION

The rejections under 35 U.S.C. § 103 of claims 1, 3-6, 12 and 32 over Fountain, claim 7 over Fountain in view of Young, and claims 8-11 over Fountain in view of Hawley, are reversed.

REVERSED

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge

Terry J. Owens
TERRY J. OWENS
Administrative Patent Judge

BOARD OF PATENT
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AND
INTERFERENCES


JENNIFER D. BAHR
Administrative Patent Judge

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